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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,264

02/05/2004

George Bayer

2350.422

8672

23405

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03/07/2006

HESLIN ROTHENBERG FARLEY & MESITI PC
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ALBANY, NY 12203

EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,264

Applicant(s)

BAYER ET AL.

Examiner

David C. Reese

Art Unit

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9,10,12-14,23-25,29-39,50,51 and 54-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,9,10,12-14,23-25,29-38,50,51 and 54-69 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This office action is in response to Applicant's amendment filed 1/6/2006.

Status of Claims

- [1] Claims 1, 3-4, 7, 9, 10, 12-14, 23-25, 29-39, 50-51, and 54-69 are pending.

Specification

- [2] The amendment filed 1/6/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claims 68 and 69 state the following: "deformations in the continuous connector" and "the continuous connector comprising elongated loops" respectively. Said statements are not supported by the original disclosure and thus are considered new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

- [3] Claims 68-69 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. Claims 68-69 state the following: "deformations in the continuous connector" and "the continuous connector comprising elongated loops" respectively. Said statements are considered new matter and thus fail to comply with the written description requirement.

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[4] The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Further, Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the instant case, it is unclear as to how the second ends of the first and second wire connector can both be inserted into the first aperture of the second ornament.

[4] Claim 66 recites the limitation "the loading" in the instant claim and dependent one therefrom. There is insufficient antecedent basis for this limitation in the claim.

Claim 67 recites the limitation "the misalignment" in the instant claim and dependent one therefrom. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[6] Claims 1, 3-4, 9-10, 12-14, 23-25, 50, 54-58, 63-64 are rejected under 35 U.S.C. 102(b) as clearly anticipated by EP 0200924, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of EP 0200924 is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

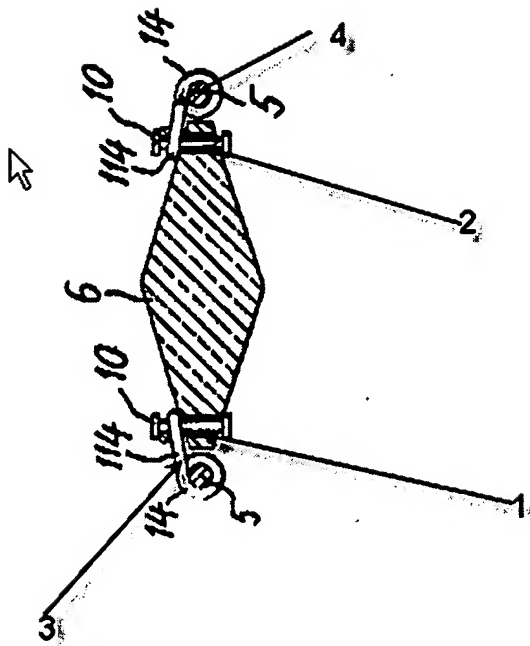
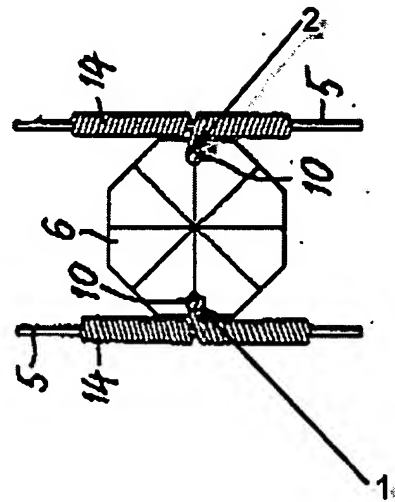
As for Claim 1, EP 0200924 teaches of a arrangement/link construction for a crystal pendant, the arrangement (Fig. 11, see figures below) comprising:

- a first ornament (6) having at most a first aperture (1) and a second aperture (2);
- a second ornament (above or below 6) having at most a first aperture (1) and a second aperture (2); and

- a first connector wire (page 11, line 5, "...a wire 14 is helically wound around each lateral rod 5...") (left 14) having a first end (3) [adapted to be] mounted to the first aperture (1) of the first ornament (6) and a second end (the end attached to the ornament above or below) adapted to be mounted to the first aperture (1) of the second ornament (above or below 6); and

- a second connector wire (page 11, line 5, "...a wire 14 is helically wound around each lateral rod 5...") (right 14) having a first end (4) [adapted to be] mounted to the second aperture (2) of the first ornament (6) and a second end (the end attached to the ornament above or below) [adapted to be] mounted to the second aperture (2) of the second ornament (above or below 6).

whereby the second aperture (2) of the first ornament (6) is laterally disposed from the first aperture (1) of the first ornament (6).



Re: Claim 3, wherein the second aperture (2) of the second ornament (above or below 6) is laterally disposed from the first aperture (1) of the second ornament (above or below 6).

Re: Claim 4, wherein the second aperture (2) of the first ornament (6) is opposite the first aperture (1) of the first ornament (6).

Re: Claim 9, further comprising at least a third ornament (two above or below 6) having at least one aperture (1) and at least one third connector (14 from the second ornament to the third ornament) connecting the second ornament (above or below 6) and the third ornament (two above or below 6).

Re: Claim 12, wherein the decorative ornaments (6) comprises one or more of beads, crystals, stones, and gems (6).

Re: Claim 13, wherein at least the first connector (14) comprises a metallic wire having a diameter between about .0625 inches and about .125 inches.

Re: Claim 14, wherein the first ornament (6) and the second ornament (6) comprise octagonal ornaments (6).

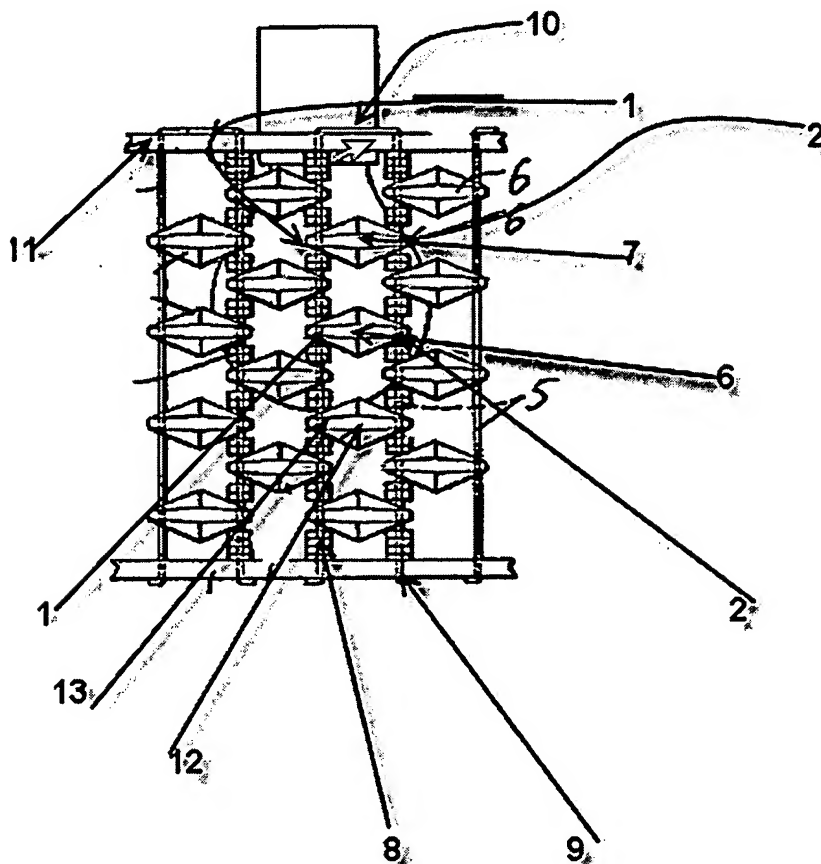
[7] As for Claim 1, EP 0200924 teaches of a arrangement/link construction for a crystal pendant, the arrangement (Fig. 23, see figure below) comprising:

a first ornament (6) having at most a first aperture (1) and a second aperture (2);
a second ornament (7) having at most a first aperture (1) and a second aperture (2); and
a first connector wire (8) (page 14, line 23, "...of a generally metallic wire forming...")
having a first end [adapted to be] mounted to the first aperture (1) of the first ornament (6) and a
second end [adapted to be] mounted to the first aperture (1) of the second ornament (7); and

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a second connector wire (9) (page 14, line 23, "...of a generally metallic wire forming...") having a first end [adapted to be] mounted to the second aperture (2) of the first ornament (6) and a second end adapted to be mounted to the second aperture (2) of the second ornament (7).

whereby the second aperture (2) of the first ornament (6) is laterally disposed from the first aperture (1) of the first ornament (6).



Re: Claim 3, wherein the second aperture (2) of the second ornament (7) is laterally disposed from the first aperture (1) of the second ornament (7).

Re: Claim 4, wherein the second aperture (2) of the first ornament (6) is opposite the first aperture (1) of the first ornament (6).

Re: Claim 10, wherein at least the first connector (8) comprises at least one-pre-formed U-shaped wire connector (10) having ends adapted to be inserted into and secured to an aperture of an ornament (6).

Re: Claim 12, wherein the decorative ornaments (6) comprises one or more of beads, crystals, stones, and gems (6).

Re: Claim 13, wherein at least the first wire connector (8) comprises a metallic wire having a diameter between about .0625 inches and about .125 inches.

Re: Claim 14, wherein the first ornament (6) and the second ornament (7) comprise octagonal ornaments.

As for Claim 23, EP 0200924 teaches of a arrangement/link construction for a crystal pendant, the arrangement (Fig. 23, see figure above) comprising:

at least one ornament (6 or 7) having a first aperture (1) and a second aperture (2); and

at least one hook (10) having a first end (8) adapted to be inserted and secured to the first aperture (1) of the ornament (6 or 7), a second end (9) adapted to be inserted and secured to the second aperture (2) of the ornament (6 or 7), and a loop (below 10) positioned between the first end (8) and the second end (9), the loop (below 10) [adapted to be] hung from a support (11);

wherein, when hung by the loop (below 10), the second aperture (2) of the ornament (6 or 7) is laterally disposed from the first aperture (1) of the ornament (6 or 7).

Re: Claim 24, wherein the one or more decorative ornaments (6) comprise one or more of beads, crystals, stones, and gems (6).

Re: Claim 25, wherein the at least one hook (10) comprises a wire (8, 9) having a diameter between about .0625 inches and about .125 inches.

Re: Claim 50, wherein the first ornament (6) and the second ornament (7) comprise two of a plurality of ornaments providing an ornament chain (Fig. 23).

Re: Claim 63, wherein the first connector (8) and the second connector (9) comprise at least one pre-formed U-shaped connector (10) having ends adapted to be inserted into and secured to an aperture (1, 2) of an ornament (6,7).

Re: Claim 64, wherein the first connector (8) and the second connector (9) comprise metallic wire having a diameter between about .0625 inches and about .125 inches.

As for Claim 54, EP 0200924 teaches of an arrangement for connecting decorative ornaments the arrangement (Fig. 23, see figure above) comprising:

- a first ornament (6) having at most a first aperture (1) and a second aperture (2);
- a second ornament (7) having at least a first aperture (1);
- at least a third ornament (12) having at least one aperture (13); and
- at least one continuous connector (8) passing through an aperture of at least the first ornament (6), the second ornament (7), and the third ornament (12), and wherein the continuous connector (8) comprises means to engage and secure the first ornament (6), the second ornament (7), and the third ornament (12) in spaced relationship with each other;

whereby the second aperture (2) of the first ornament (6) is laterally disposed from the first aperture (1) of the first ornament (6).

Re: Claim 55, wherein the at least one continuous connector (8) comprises a connector fabricated from one of sheet and plate.

Re: Claim 56, wherein the at least one continuous connector (8) comprises at least two continuous connectors (8, 9).

Re: Claim 57, wherein the at least one continuous connector (8, 9) fabricated from one of sheet and plate is fabricated by one or more of the following processes: laser cutting, water-jet cutting, and electro-discharge machining.

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Re: Claim 58, wherein the first ornament (6), second ornament (7), and third ornament (12) comprise a plurality of ornaments providing an ornament chain.

[8] Claims 29-38, 60-62 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Schonbek, US- 5,144,541, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

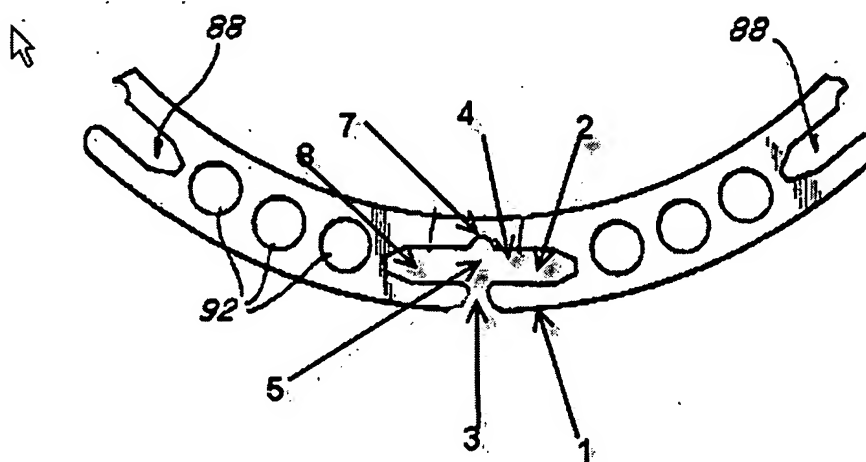
As for Claim 29, Schonbek teaches of a gallery assembly for chandeliers, the device comprising (See Figure below):

a plate having an outer edge (1); and

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a channel in the plate (2) having an open first end (3) located at the edge of the plate (1), a closed second end (4), the channel (2) comprising a horizontal passage (2) and at least one vertical passage (6) located between the open first end (3) and the closed second end (4);

wherein the channel (2) [is adapted to] receive the hook (82) of the ornament (76) and support the hook (82) in the closed second end of the channel (Fig. 8 of Schonbek).



Re: Claim 30, wherein the channel (28) further comprises an expansion (7) in the vertical passage (6).

Re: Claim 31, wherein the closed second end (4) comprises a convergent closed second end (7).

Re: Claim 32, wherein the convergent closed end (7) converges to a point (7).

Re: Claim 33, wherein the channel (2) comprises a channel (3) that passes through the thickness of the plate.

Re: Claim 34, wherein the at least one vertical passage (6) of the channel (2) comprises at least two vertical passages (6, 8).

Re: Claim 35, wherein the mounting hook (82) of the ornament (76) comprises a mounting loop (82 in Fig. 8).

Re: Claim 36, wherein the mounting loop comprises a wire mounting loop (82 in Fig. 8).

As for Claim 37, Schonbek teaches of an arrangement for mounting a decorative ornament on a fixture, the decorative ornament having a preferred direction of orientation; the arrangement comprising:

a mounting hook (82 in Fig. 8) adapted to be attached to the decorative ornament (76);

a plate having a planar surface and an edge (1); and

a channel (2) in the plate having an open first end (3) located at the edge of the plate (1), a closed second end (4), comprising a horizontal passage (2) and at least one vertical passage (6) located between the open first end (3) and the closed second end (4);

wherein the channel (2) [is adapted to] receive the hook (82) of the ornament (76) and support the ornament (76) whereby the preferred direction of orientation of the ornament (76) is directed substantially parallel to the planar surface of the plate (Fig. 8).

Re: Claim 38, wherein the fixture comprises a circular fixture (Fig. 5) having a radial direction (70 to 1), wherein the planar surface of the plate and the preferred direction of orientation of the ornament are directed in the radial direction of the fixture.

Re: Claim 60, wherein the plate comprises a vertically oriented plate (70 in Fig. 6).

Re: Claim 61, wherein the edge comprises a bottom edge of the vertically oriented plate (bottom of 112).

Re: Claim 62, wherein the channel (2) further comprises an abrupt enlargement in width (8-2) [adapted to] obstruct disengagement of the mounting hook (82) from the channel (2).

Allowable Subject Matter

[9] Claim 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art, either alone or in combination with corresponding limitations as stated above, fails to teach or disclose of a hook as stated from Claim 37 comprising a connector having a first end inserted into a first aperture of a ornament and a second end of the said connector inserted in the a second aperture of said ornament (from Claim 39); with said hook being attaching to the channel in the plate with specifications as claimed in Claim 37.

Claim Rejections - 35 USC § 103

[10] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[11] Claims 51, 59, 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0200924, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claims 51, 59, and 65, EP 0200924 teaches of that from Claim 1 and Claim 54, respectively.

The difference between the claims and EP 0200924 is that the claims recite that the ornament chain is at least 5 feet in length; and that said ornament chain comprises a single-row chain of at least 10 ornaments. It would have been an obvious matter of design choice to alter the size and length of the ornamental chain by adding ornaments to said chain. First and foremost, it has been held that mere duplication of the essential working parts of a device involves only routine skilled the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8); and further, since such a modification would have involved a mere change in the size of a component in its entirety, such is generally recognized as being within the level or ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Re: Claim 66, wherein the first wire connector and the second wire connector [are adapted to reduce the loading on the at least 10 ornaments compared to the loading on ornaments mounted with single wire connectors].

Re: Claim 67, wherein the first wire connector and the second wire connector [are adapted to minimize the misalignment of the at least 10 ornaments compared to ornaments mounted with single wire connectors].

The above statements in brackets are examples of intended use as they fail to further limit the structure of the claimed invention.

Note that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Response to Arguments

[12] Applicant's amendment, see amendment and remarks filed 1/6/2006, with respect to the rejection(s) of claim(s) under DE 2127913, have been fully considered. Therefore, the rejection with regard to DE 2127913 has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of EP 0200924 (see above), and all arguments with respect to said claims are considered moot to new grounds of rejection.

[13] Applicant's arguments filed 1/6/2006 regarding rejections under 35 U.S.C. 102 with regard to Schonbek (Claims 29-38, 60-62) have been fully considered but are not persuasive. In response, the examiner would like to direct the applicant's attention to the figure provided from Schonbek (see above) that better illustrates the anticipatory features of Schonbek with regard to the instant claimed invention.

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Conclusion

[14] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

[15] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR



2/22/06

David Reese
Assistant Examiner
Art Unit 3677



ROBERT J. SANDY
PRIMARY EXAMINER